

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-34 remain in this application.

The Examiner requested an accurate translation of the PCT document, which is being provided with this response. The Examiner also requested evidence that the PCT application was copending with this application. Applicant's representative has requested such evidence from applicant, and will provide it to the Examiner as soon as possible.

Claim 23 was rejected under 35 U.S.C. §112, second paragraph, for having insufficient antecedent basis for the phrase "said data filter". The claim has been amended to depend on a claim properly introducing the phrase, making the rejection moot.

Claims 1-3, 11-15, and 18-20 were rejected under 35 U.S.C. §102(e) as being anticipated by Ausems *et al.* (U.S. 6,434,403). Claims 4-7, 21-22, 32, and 34 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ausems in view of Emmoft *et al.* (U.S. 6,424,845). Claims 23-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ausems in view of Emmoft, and in further view of Musgrave *et al.* (U.S. 6,483,930). Claims 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ausems in view of Musgrave. For the following reasons, the rejections are respectfully traversed.

Claim 1, as amended, recites a portable radio module for receiving "programs of a central radio sender" and having an identification module for storing "user-specific data" for sending at close range via a "contactless interface" to "external devices", wherein "said radio receiver can receive program-accompanying data".

None of the references suggest a portable radio module for receiving "programs of a central radio sender" as recited in the claim. Thus, claim 1 is patentable over the references.

Originally, claim 4 introduced the limitation of receiving "program accompanying data" which is now included in amended claim 1. The Examiner failed to address this limitation in the Office action. Applicant can find no such teaching in any of the references. Accordingly, claim 1 is patentable over the references for that reason as well.

Furthermore, the Examiner admits that Ausems does not teach remote programming of a SIM card. Instead, the Examiner cites Emmoft as teaching this limitation of the claim. However, Emmoft does not suggest using a SIM card for storing "user-specific data" for sending at close range via a "contactless interface" to "external devices" as recited in the claim. Hence, claim 1 is patentable over the references for this reason as well.

Claims 2-31, which depend, directly or indirectly, on claim 1, are thus patentable over the references for any of the reasons discussed above, as well as for the limitations contained therein.

Claim 32 is directed toward a "portable digital audio broadcasting receiver" including "means for storing DAB program-accompanying data" in a storage area. Ausems does not teach an audio broadcasting receiver, as the reference does not teach receiving audio via "broadcast". Furthermore, the Examiner has admitted that Ausems does not teach "storing DAB program-accompanying data" and thus cites Emmoft as teaching this element of the claim. However, although the Examiner has identified some data stored by the Emmoft device, there is no suggestion of storing DAB program-accompanying data because the reference does not suggest any Digital Audio Broadcasting (DAB) capability or support. Accordingly, claim 32 is patentable over the references. Claim 33, which depends on claim 32, is patentable over the references for at least the same reasons.

Claim 34, as amended, recites the step of "sending authorization data in broadcast mode as program-accompanying data". The Examiner fails to show where any reference teaches this element of claim 34. Hence, claim 34 is patentable over the references.

Claim 34 also recites "filtering the authorization data concerning the user of a particular one of the radio receivers in a filter in the particular radio receiver". The Examiner admits that Ausems does not teach this step, and thus cites Emmoft as teaching this claim limitation. However, the cited section does not discuss filtering as required by the claim. It merely discusses downloaded information, without any discussion of authorization data or filtering (authorization data is not a "call sign" or "identity code" as no authorization is occurring). Accordingly, claim 34 is patentable over the references for this reason as well.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has merely listed an advantage provided by the secondary reference as motivation. The Examiner has not provided specific motivation for adding the particular features of the secondary reference(s) to the primary reference, as required.

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for *combining* the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness is not supported by the Office action and thus the rejections are improper, and should be withdrawn.

Claims 8-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ausems in view of Applicants Admitted Prior Art (AAPA), and claims 16-17, 30-31, and 33 are rejected in further view of Wood Jr. (6,118,789). For the following reasons, the rejection is respectfully traversed.

Claims 8-10, which depend on claim 1, are patentable over the references for at least the reasons discussed for claim 1.

Furthermore, the Examiner has not provided the proper motivation for adding the features claimed to be AAPA. Even if admitted prior art, the Examiner must provide the proper motivation for adding the feature to the primary reference. As discussed above, such motivation cannot be merely a benefit. In addition, such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph). Yet, the Examiner cites benefits of the AAPA that can only be obtained from the application itself. Thus, the Examiner has failed to provide the proper motivation, and thus the rejection is improper.

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Reply to Office action of October 28, 2004

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34225

Respectfully submitted,

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